

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS APPLE, PAUL NOBLE, JOHN FOOTEN
and ANDREW KLEIN

MAILED

MAY 06 2004

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2003-0938
Application No. 08/736,143

ON BRIEF

Before BARRETT, FLEMING, and DIXON, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

DECISION ON REQUEST FOR REHEARING

Appellants filed a request for rehearing on February 17, 2004 of our decision entered December 16, 2003.

The request for rehearing is dismissed.

OPINION

Appellants argue that Rayson and Higgins are non-analogous art. See pages 2 and 3 of the request. Appellants argue that those skilled in the art in the field of displaying financial information would not turn to a reference that is directed to improvement of word processing.

In determining whether a claim would have been obvious at the time of the invention, the Examiner must first determine the scope and content of the prior art. **Graham v. John Deere Co.**, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). "Although § 103 does not, by its terms, define the 'art to which [the] subject matter [sought to be patented] pertains,' this determination is frequently couched in terms of whether the art is analogous or not, i.e., whether the art is 'too remote to be treated as prior art.'" **In re Clay**, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992) **citing In re Sovish**, 769 F.2d 738, 741, 226 USPQ 771, 773 (Fed. Cir. 1985).

In making this determination, we must consider two criteria. First, it must be determined if the prior art is from the same field of endeavor, regardless of the problem addressed. Secondly, even if the prior art is not in the same field of endeavor, it must be determined whether the reference still is

reasonably pertinent to the particular problem with which the inventor is involved. *In re Clay, supra*, 966 F.2d at 658-659, 23 USPQ2d at 1060.

We do not agree with Appellants' characterization that Higgins is simply directed to a display for financial information. Higgins teaches a system for distributing, processing and displaying financial information. See the title of Higgins, column 1, lines 1-4. It is an object of the Higgins invention to provide improved user friendly apparatus for communicating, storing, processing and displaying financial market information, news and other original and derivative data. See Higgins, column 1, lines 13-16. It is another object of the Higgins invention to provide a user controlled subscriber work station which permits access to dynamically changing sub-population of securities determined by the user and allows the user customization of that data. See Higgins, column 1, lines 25-54. Furthermore, the Higgin's invention employs processing of text data. In particular, Higgins teaches that the system is to make use of the market and news information generated by news wire sources. The work stations 110 have a keyboard 112 which may be employed by a user to specify various kinds of information from the various news wire sources. Higgins teaches that this

data may be formatted in a variety of ways. See Higgins, column 4, lines 21-44. Thus, Higgins is confronted with a problem of how to process the text data provided by news wire sources.

Similarly, Higgin's invention is also concerned with the problem of processing data provided by a ticker plant 35.

Higgins teaches a multi-window format chosen by the user by keyboard 112 which allows the user to personalize the ticker data and trade message data. See Higgins, column 4, lines 45 through column 5, line 40. Thus, Higgins is concerned with how to process this text data as well.

Thus, we find that Higgins teaches a system for processing financial information and would have led those skilled in the art to consult text processing arts. Furthermore, we find that Rayson is also directed to the same problem of how to process text. Therefore, we find that Rayson is reasonably pertinent and therefore we find the references applied are analogous.

Appellants argue that neither Higgins, Rayson or Lauer provide any motivation that would have led one of ordinary skill in the art to combine the prior art to render Appellants' invention obvious. Appellants argue that it is only the benefit of hindsight that provides the necessary motivation to combine

the teachings of Rayson with Higgins. See pages 3-4 of the request.

While this court indeed warns against employing hindsight, its counsel is just that - a warning. That warning does not provide a rule of law that an express, written motivation to combine must appear in prior art references before a finding of obviousness. Stated differently, this Court has consistently stated that a Court or Examiner may find a motivation to combine prior art references in the nature of the problem to be solved.

Ruiz v. Chance, Slip Op. No. 03-1333 (Fed. Cir. 1/29/04). Also **see Pro-Mold**, 75 F.3d at 1573; **Display Techs., Inc. v. Paul Flum Ideas, Inc.**, 282 F.3d 1340, 1346-47 (Fed. Cir. 2002); **In re Huang**, 100 F.3d 135, 139 n.5 (Fed. Cir. 1996).

As we have found above, Higgins is concerned with the problem of allowing the user to customize financial information at each work station. As found above, Higgins is confronted with the problem of how to process this financial information so that the user can customize it. Furthermore, as we have pointed out above, it is the primary object of Higgins to provide an improved user friendly apparatus for communicating, storing, processing and displaying financial market information, news and other original derivative data. See Higgins, column 1, lines 13-16.

Thus, Higgins is concerned with the problem of how to allow the user to personalize the financial information according to his own needs and personal preferences.

Turning to Rayson, we find that Rayson is concerned with the same problem of how to process information. As we have found in our opinion, Rayson teaches a method and text processor system that gives the user a relative easy way to automatically replace a character string with a logo. See Rayson, column 9, lines 50-54. Thus, we find that those skilled in the art confronted with the problem of how to allow a user to customize the financial data of Higgins would look to Rayson's teaching of allowing character strings to be replaced by a logo as taught by Rayson to allow further customerization and user friendly display of the financial market information.

Appellants further argue that even assuming there is motivation to combine, Higgins, Lauer and Rayson does not disclose or teach associating a firm corporate logo with financial information received from a stock ticker feed as recited by independent claim 17. In particular, Appellants argue that the references do not teach "a corporate logo juxtaposed with financial information" and "real-time textual data associated with financial instruments of entities identified by

instrument identifiers in a feed received by the system." See pages 4-7 of the request.

As pointed out above, as well as in our opinion, we have found that Higgins does teach real-time textual data associated with financial instruments of entities identified by instrument identifiers in a feed received by the system as recited in Appellants' claim 17. Furthermore, as found in our opinion above, we found that Higgins teaches a system that would automatically recognize a character screen and insert a logo for that particular character screen. Therefore, we have found that the combination of Higgins, Lauer and Rayson does teach all the limitations recited in Appellants claim 17.

Appellants make further arguments directed to independent claim 27 and dependent claims 4, 5, 18-31, 34, 37 and 38. These arguments have not been presented to us before. Similarly, Appellants present a new argument as to the definition of the term "graphic symbols." Appellants has not presented this argument as well in the brief or the reply brief.

Reconsideration under 37 CFR § 1.197(b) must be based upon the same record as the original decision. It is not a vehicle for introducing new argument that has not been presented previously in the record and has not been considered by the

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Examiner. In ***Ex parte Hindersinn***, 177 USPQ 78, 80 (Bd. App. 1971), it was held that a new argument advanced in a request for reconsideration but not advanced in the brief or reply brief is not properly before the Board because an argument advanced in such a manner has not afforded the Examiner an opportunity to respond to the new argument. "A party cannot wait until after the Board has rendered an adverse decision and then present new arguments in a request for reconsideration." ***Cooper v. Goldfarb***, 154 F.3d 1321, 1331, 47 USPQ2d 1896, 1904 (Fed. Cir. 1998).
Appellants request for rehearing is denied.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REHEARING DENIED

Lee E. Barrett

LEE E. BARRETT)
Administrative Patent Judge)
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Michael R. Fleming

MICHAEL R. FLEMING) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES

Joseph L. Dixon

JOSEPH L. DIXON)
Administrative Patent Judge)
)

MRF/lbg